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10/027,954	12/19/2001	Frank Venegas JR.	IDS-14602/14	2646
7590	07/09/2004			EXAMINER SLACK, NAOKO N
John G. Posa Gifford, Krass, Groh et al Suite 400 280 N. Old Woodward Ave. Birmingham, MI 48009			ART UNIT 3635	PAPER NUMBER
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GROUP 3600

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/027,954

Filing Date: December 19, 2001

Appellant(s): VENEGAS, FRANK

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John G. Posa  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 4/29/2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 1-4 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

5,261,647A

VENEGAS, JR. et al.

11-1993

5,370,368A                  TERRELS et al.                  12-1994

5,342,037A                  VENEGAS, Jr.                  10-1994

**(10) Grounds of Rejection**

***Claim Rejections - 35 USC § 112***

1. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, "a saddle weld" is not disclosed in the specification.

***Claim Rejections - 35 USC § 103***

2. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,261,647 to Venegas, Jr. et al. in view of US Patent 5,370,368 to Terrels et al.

Regarding claims 1 and 2, Venegas, Jr. et al. discloses a guard rail assembly comprising a pair of vertical metal side members (22, Figure 2 and column 2, lines 49-50) covered by polymeric sheathing (26 and 30, Figure 2), a horizontal metal member (50, Figure 2 and column 2, lines 56-57) covered by polymeric sheathing (54, Figure 2, column 2, lines 57-58) spanning the two vertical members, the horizontal member has a length that extends beyond the

outermost extent of the vertical side members (as best illustrated in Figure 1).

The vertical and horizontal members are attached by way of removable fastener (38, Figure 2 and column 3, lines 4-6).

While Venegas, Jr. et al. does not disclose that the horizontal and vertical rails are connected with a saddle weld, Terrels et al. shows a composite plastic and metal handrail assembly and discloses that the horizontal and vertical rails can be connected by saddle welding (column 2, lines 60-63) to form a seamless and strong connection. In view of Terrels et al., it would have been obvious for one of ordinary skill in the art to connect the rails of Venegas Jr. et al. with saddle welds to improve the outward appearance (column 6, lines 34-38) and strength of the guard rail and also permits disassembly of the components (column 6, lines 6-10, 23-28). Venegas Jr. et al. is motivated to provide guardrails that can be assembled and disassembled, with the strength of steel and energy absorbing, low maintenance benefits of plastic (column 1, lines 10-26).

Claim 4:

Terrels et al. also teaches attachment of the vertical side members and horizontal member using a removable fastener (column 4, lines 1-11).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,261,647 to Venegas, Jr. et al. in view of US Patent 5,370,368 to Terrels et al. as applied to claim 1 and further in view of US Patent 5,354,037 to Venegas, Jr.

In the guard rail assembly of Venegas, Jr. et al., the horizontal member extends beyond the outermost extent of the vertical side members. Venegas, Jr. et al. does not show the vertical side members with a length that extends beyond the upper extent of the horizontal member; however, such an arrangement is shown in the guard rail system of US Patent 5354037 to Venegas, Jr. In view of US Patent 5354037, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the guard rail of Venegas, Jr. et al. such that the vertical members extend beyond the outermost extent of the horizontal members to simulate the appearance of post and rail, a popular fencing style.

#### **(11) Response to Argument**

In paragraph A, applicant disagrees with examiner's rejection of claim 1 under 35 USC 112, first paragraph, that a "saddle weld" is not disclosed in the specification in a way to enable one skilled in the art to make and/or use the invention. However, a careful study of the disclosed invention and drawings reveals that the application fails to identify, describe or illustrate a "saddle weld."

Applicant argues that "saddle welds are notoriously well known to anyone of skill in the art to which this invention pertains" and that "a typical saddle weld is shown at least in Figure 3." Figure 3 illustrates the detail of the connection between a horizontal member (204, Figure 2) and vertical member (202', Figure 2). Neither a numeral nor a description in Figure 3 indicates a "saddle weld."

Referring to examiner's rejection of claims 1, 2 and 4 under 35 U.S.C.

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103(a), where examiner uses prior art to Terrels et al. to disclose a saddle weld, applicant questions how examiner can use prior art to teach a feature which has been considered “non-enabling” in the application. Absent an enabling disclosure of a “saddle weld,” the examiner used the terms “saddle” and “weld” to search a connection for vertical and horizontal members without destroying the structural features of the invention as best understood by applicant’s disclosure.

In paragraph B, in response to the rejection of claims 1,2 and 4 under 35 U.S.C. 103(a) to Venegas, Jr. et al. ‘647 in view of Terrels et al., applicant argues that Terrels et al. does not teach or suggest a “saddle weld”.

Since Terrels et al. discloses a “saddle” formation on a pipe (column 3, lines 53-56 and 33, Figure 4), and Terrels et al. discloses connection of abutted pipes with a “weld” (column 2, lines 60-63), Terrels et al. appears to meet the limitations of a “saddle weld” that could be applied to the connection of vertical and horizontal structural members as best understood by applicant’s disclosure.

Applicant further argues that “there is no teaching or suggestion whatsoever in Terrels et al. to use the system set forth in the Venegas, Jr. reference” (page 4, first paragraph, lines 8-9) and that “the only motivation of Terrels et al. to use a butt-joint, is to improve appearance” (page 3, paragraph B, lines 9-10). Improvement in appearance is enough to motivate modification of structural elements, particularly in structural elements that are visible to the public. Since the guardrail assembly of Venegas, Jr. et al. is used in public places, such as porches, balconies, stadiums and stairways (column 1, lines 5-

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9), a concern for appearance would motivate one of ordinary skill in the art to use the “saddle welds” as taught by Terrels et al. to connect the vertical and horizontal members of Venegas et al. '647 in an aesthetically improved manner.

Furthermore, applicant states that saddle welds are “notoriously well known to anyone of skill in the art to which this invention pertains” (paragraph A, lines 4-5); therefore, such a connection lacks novelty and would be an obvious connection choice to one of ordinary skill in the art.

In paragraph C, in response to the rejection of claim 3 under 35 U.S.C. 103(a) to Venegas, Jr. et al. '647, Terrels et al., and Venegas, Jr. '037, applicant argues that there is no evidence from the prior art to motivate a post and rail arrangement. As stated in the final rejection, such an arrangement is well known in the art, as evidenced by prior art to Venegas, Jr. '037, which offers an alternative embodiment or design choice to one of ordinary skill in the art. Venegas, Jr. '037 is cited as an alternate design of a guardrail system that employs metallic members covered by polymeric sheathing.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



NS  
June 10, 2004

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